

REMARKS

Claims 1-14 are currently pending in the application. By this response, no claims are amended, added, or canceled. Applicants respectfully request reconsideration in view of the following remarks.

Telephone Interview

Applicants thank Supervisory Patent Examiner Chaney for the courtesy extended during the telephone interview dated December 10, 2007, between Examiner Chaney and Applicants' representative. In the telephone interview, Applicants' representative pointed out that the sole outstanding issue in the Final Office Action dated November 19, 2007, is the provisional double patenting rejection of claims 1-14 in view of another pending application. Examiner Chaney agreed that the provisional double patenting rejection should be withdrawn.

Provisional Double Patenting Rejection

Claims 1-14 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/932,337 (the '337 application). This rejection is respectfully traversed.

(i) The provisional double patenting rejection is the only rejection in this application and, therefore, should be withdrawn.

Initially, Applicants note that this is a provisional double-patenting rejection, and that this provisional double patenting rejection is the only rejection remaining in the instant application. Therefore, according to MPEP §804, the provisional double patenting rejection should be withdrawn and the instant application permitted to issue. More specifically, MPEP §804 states:

If a “provisional” nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications ... **the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer.**

(MPEP §804)

Since the instant application was filed before the ‘334 application, and because the provisional double patenting rejection is the only rejection remaining in the instant application, MPEP §804 requires that the provisional double patenting rejection be withdrawn and the instant application permitted to issue.

(ii) The double patenting rejection is improper because the Examiner has failed to establish a prima facie case and because claims 1-14 of the instant application are patentably distinct from the claims of the ‘337 application.

Because this is a provisional rejection, Applicants are not required to provide any comments as to whether the claims of the instant application are obvious in view of the claims of the ‘337 application, and are not providing a terminal disclaimer at this time. However, in a good-faith effort to advance prosecution, Applicants provide the following rebuttal of the rejection.

The Examiner provides the following explanation of the provisional double patenting rejection:

Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art to rearrange parts of the invention.
[Final Office Action, page 2].

Applicants respectfully disagree with this rejection because (1) the explanation fails to establish a *prima facie* case of obviousness-type double patenting, and (2) claims 1-14 of the present invention recite features that are not recited in claims 1-10 of the ‘337 application.

First, the above-noted explanation fails to establish a *prima facie* case of obviousness-type double patenting. According to MPEP §804, an obviousness type double patenting rejection must be made in light of the 35 U.S.C. §103(a) factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). More specifically,

Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of the invention defined in a claim in the patent.

(MPEP §804)

Applicants submit that the above-noted explanation of the double patenting rejection fails to make clear the differences between the inventions defined by the conflicting claims. The explanation includes no comparison of the claims in the '337 application and the claims of the instant application. The Examiner's contention that it would have been obvious to rearrange parts does not serve to adequately address and compare the features recited in the claims, as required by MPEP §804. Therefore, the rejection is improper on its face, and should be withdrawn for this reason alone.

In any event, Applicants submit that claims 1-14 of the present invention recite features that are not recited in claims 1-10 of the '337 application. For example, claim 5 of the present application recites the board is ground; however, this is not recited in any of claims 1-10 of the '337 application. Additionally, claims 8 and 9 of the present application recite mixing/scattering at least one of antibacterial and antistatic additives; however, antibacterial and antistatic additives are not recited in any of claims 1-10 of the '337 application. Also, claim 11 of the present application recites providing a filler comprising wood fiber, wood dust, metals, mineral

substances, plastics, or ash; however, such a filler is not recited in any of claims 1-10 of the '337 application. Therefore, the double patenting rejection is improper because at least claims 5, 8, 9, and 11 of the present application recite features that are not recited or suggested by claims 1-10 of the '337 application.

Accordingly, for all of the above-noted reasons, Applicants respectfully request that the provisional double patenting rejection over claims 1-14 be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,
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